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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,148	07/25/2000	Yasuhiro Miyamoto	OPS Case 498	7111

7590 05/23/2002  
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EXAMINER

HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 05/23/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/625,148

Applicant(s)

MIYAMOTO ET AL.

Examiner

Jacqueline V. Howard

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The request filed on March 13, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/625,148 is acceptable and a CPA has been established. An action on the CPA follows.

This Office Action is in response to the CPA filed and the request for reconsideration and Declaration filed under 37 CFR 1.132.

Claims 1 to 6 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 8 to 12, 23 and 25 of copending Application No. 09/349,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons of record set forth in the Office Action dated March 14, 2001 and maintained in the Office Action dated September 13, 2001.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1 to 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morway et al (2,739,127) combined with Doner et al (5,763,370) or Tanaka et al (5,858,931) for the reasons of record as fully set forth in the Office Action dated March 14, 2001 and maintained in the Office Action dated September 13, 2001.

Applicants filed a request for reconsideration and presented a Declaration under 37 CFR 1.132, which they allege further, establishes the patentability of the presently claimed invention.


The Declaration of Motohara Akiyama under 37 CFR 1.132 filed February 27, 2002 is insufficient to overcome the rejection of claims 1 to 6, 8 and 9 based upon Morway et al combined with Doner et al or Tanaka et al as set forth in the last Office action.

The data submitted is not deemed to constitute unexpected results. Nor is the showing deemed to be commensurate in scope with what is being claimed. Applicant has prepared several comparative grease compositions wherein it appears that carbonates having different alkyl groups are combined. Even the example of the present invention appears to be a mixture of C13-C15 carbonates. There is no indication of how much of C13, C14 and C15 carbonates is present. It is not clear how these mixtures of carbonates are comparative examples since the grease of the present invention contains only one carbonate compound with R groups having from 13 to 15 carbon atoms. A closer comparison would be the carbonates of the present invention, i.e. a C13 or C14 or C15 carbonate to a carbonate of Morway outside of that range, e.g. C12 or C16.

Any inquiry concerning this communication should be directed to J. Howard at telephone number (703) 308-2514.

J. Howard/om

May 13, 2002

  
JACQUELINE V. HOWARD  
PRIMARY EXAMINER  
GROUP 1700